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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,898	11/26/2003	Lane Smith	P-103786.3 (UTI)	2886
7590	05/19/2006		EXAMINER	
Daniel D. Chapman, Esq. JACKSON WALKER L.L.P. 112 E. Pecan Street, Suite 2100 San Antonio, TX 78205			QIN, JIANCHUN	
		ART UNIT	PAPER NUMBER	
		2837		

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/722,898	SMITH ET AL.	
	Examiner	Art Unit	
	Jianchun Qin	2837	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 17 January 2006.
- 2a) This action is **FINAL**.                                   2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 8,11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 8,11 and 13-17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

<ol style="list-style-type: none"> <li>1)<input type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____</li> </ol>	<ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: _____</li> </ol>
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**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/17/06 has been entered.

***Terminal Disclaimer***

2. The terminal disclaimer filed on 01/17/2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US 6,530,577 has been reviewed and is accepted. The terminal disclaimer has been recorded.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 8 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Behrenfeld (5,986,196).

Regarding claim 8, Behrenfeld discloses a device comprising: a patch (22, 29, 12, 14) comprising a resilient, pliable, adhesive body (22) and an integral flexible base (29); a second patch (18), the second patch for stacking on the first patch, the first patch for attaching to the vibratable surface (8); and wherein the patch is positioned on the vibratable surface in other than a point of impact (col. 6, lines 9-12; col. 3, lines 62-65).

Regarding claim 11, Behrenfeld discloses the claimed invention. See above and Fig. 2A.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fyfe (6,806,212) in view of liyama et al. (JP02003001648A, machine English translation) and Behrenfeld (5,986,196).

Regarding claim 13, Fyfe discloses the method steps of providing a flat surface (101); applying a polyurethane mix (27, col. 4, line 23, and Fig. 1) to the flat surface, laying a sheet (26) of base material onto the polyurethane mix (Fig. 1), and allowing the polyurethane mix to cure (inherence to the process).

Fyfe does not mention expressly: releasing the cured polyurethane mix and base material from the flat surface; and applying the cured polyurethane mix and base material to a vibratable surface.

Iiyama et al. disclose a method and apparatus for producing polyurethane sheet, and teach the step of providing a release sheet (2) underneath the polyurethane mix (sections 0028, 0029 and 0034), and releasing the polyurethane mix and base material from the release sheet polyurethane mix is cured (Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teaching of Iiyama et al. in the invention of Fyfe in order to provide a technically convenient and robust method for producing a polyurethane sheet that contains a polyurethane layer coated on a base material for various usages (Iiyama et al., Abstract and section 0015).

Behrenfeld teaches a dampening patch for a drum, including: applying the patch to a vibratable surface (col. 6, lines 9-12; col. 3, lines 62-65).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teaching of Behrenfeld in the invention of Fyfe in order to make the invention of Fyfe applicable for sound dampening function for a drum (Behrenfeld, col. 3, lines 62-65). The mere application of a known invention to a specific instance by those skilled in the art would have been obvious.

Regarding claims 14-16, Iiyama et al. teach: providing a release sheet (sections 0028, 0029); removing any tapped air from the mix prior to curing (sections 0044 and 0045); cutting the cured/mixed sheet to a pre-selected shape (section 0049).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teaching of liyama et al. in the invention of Fyfe in order to provide a technically convenient and robust method for producing a polyurethane sheet that contains a polyurethane layer coated on a base material for various usages (liyama et al., Abstract and section 0015).

Regarding claim 17, the teaching of liyama et al. includes: said pre-selected shape is a rectangle (section 0049).

liyama et al. do not mention said rectangle has an area between about 1 sq. inch and 12 sq. inches. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose an optimum value for the size of the rectangle, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Response to Arguments***

7. Applicant's arguments filed 01/17/06 with respect to claims 8, 11 and 13-17 have been fully considered but they are moot in view of the new ground(s) of rejection.

Claims 8 and 11 are rejected as new evidence has been found from the Behrenfeld patent to teach the limitation that the patch is positioned on the vibratable surface in other than a point of impact. Detailed response is given in section 3 as set forth above in this Office Action.

Claims 13-17 are rejected as new evidence has been found from the Behrenfeld

Art Unit: 2837

patent to teach, together with the Fyfe patent, the limitation of applying the patch to a vibratable surface. Detailed response is given in section 4 as set forth above in this Office Action.

***Contact Information***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jianchun Qin whose telephone number is (571) 272-5981. The examiner can normally be reached on 8am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lincoln Donovan can be reached on (571) 272-1988. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jianchun Qin  
Examiner  
Art Unit 2837

JQ

  
MARLON T. FLETCHER  
PRIMARY EXAMINER